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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,253	07/28/2000	John R. Mason	1322/40/2	2388
25297	7590	06/02/2005	EXAMINER	
JENKINS, WILSON & TAYLOR, P. A. 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			NGUYEN, TOAN D	
			ART UNIT	PAPER NUMBER
			2665	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,253

Applicant(s)

MASON ET AL.

Examiner

Toan D. Nguyen

Art Unit

2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 22-50, 61-66 and 69-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-41, 73 and 74 is/are allowed.
- 6) ☒ Claim(s) 1-10, 22-34, 42-50, 61-66, 69-72, 75 and 76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/25/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application contains claims 11-21, 51-60, 67, 68, 77 and 78 have been withdrawn. The applicant is advised to cancel of withdrawn claims 11-21, 51-60, 67, 68, 77 and 78 in the next correspondence.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 4, 6, 10, 22-23, 25, 28-33, 42, 45-47, 61-65, 69, 71 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (US 6,718,178) in view of Pirkola et al. (US 6,611,516).

For claims 1 and 10, Sladek et al. disclose automatic in-line messaging system, comprising:

(a) receiving a signaling system seven (SS7) message in response to a telephony related action performed by a target end user (figure 3, reference 48) to which other end users (figure 3, reference 46) are subscribed in a presence database (figure 8, reference 44) (col. 14 lines 37-42);

(c) in response to determining that presence registration processing is required for the target end user (figure 8, reference 48), automatically generating a presence registration message including presence information usable by a presence server (figure 8, reference 42) for automatically indicating to the end users in a presence database (figure 8, reference 44) a presence status for the target end user (figure 8, reference 48) (col. 14 line 37 to col. 15 line 7); and

(d) transmitting the presence registration message to the presence server over an IP network (col. 7 lines 10-12).

However, Sladek et al. does not disclose:

(b) determining, based on the SS7 message, whether presence registration processing is required for the target end user.

In an analogous art, Pirkola et al. disclose:

(b) determining, based on the SS7 message, whether presence registration processing is required for the target end user (col. 13 lines 8-13).

One skilled in the art would have recognized presence registration processing is required for the target end user to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the presence registration processing is required for the

target end user as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to constantly maintain updated status and location information in the subscriber's Home Function (col. 13 lines 2-5).

For claims 4, 28 and 45, Sladek et al. disclose the SS7 message is a transaction capabilities application part (TCAP) message containing presence information for the end user (col. 2 line 36-38).

For claim 5, Sladek et al. disclose automatic in-line messaging system, comprising:

(a) receiving a signaling system seven 7 (SS7) message in response to a telephony related action performed by a target end user (figure 8, reference 48) (col. 14 lines 37-42);

(b) intercepting the SS7 message, extracting information from the SS7 message (col. 14 lines 37-42), the presence information including information usable by a presence server for automatically indicating to end users who are subscribed to the target end user a presence status for the target end user (figure 8, reference 48) (col. 14 line 37 to col. 15 line 7).

However, Sladek et al. does not disclose wherein the telephony-related action is the activation or change in location of a mobile telephone handset and the SS7 message is a message for updating the status of the target end user in at least one of a home location register (HLR) and a visitor location register (VLR); and using the information extracted from the SS7 message to update presence protocol information for the target end user in a presence database.

In an analogous art, Pirkola et al. disclose wherein the telephony-related action is the activation or change in location of a mobile telephone handset (col. 3 lines 1-3) and the SS7 message is a message (col. 8 lines 46-51) for updating the status of the target end user in at least one of a home location register (HLR) and a visitor location register (VLR) (col. 3 lines 1-5); and using the information extracted from the SS7 message to update presence protocol information for the target end user in a presence database (col. 3 lines 1-5).

One skilled in the art would have recognized change in location of a mobile telephone handset to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the change in location of a mobile telephone handset as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claims 6 and 25, Sladek et al. disclose wherein automatically generating a presence registration message includes automatically generating a presence protocol message (figure 8, col. 13 lines 40-41 and col. 13 lines 49-50).

For claim 22 and 30-32, Sladek et al. disclose automatic in-line messaging system, comprising:

(a) a communication module for receiving an SS7 message relating to a target end user (figure 3, reference 12) to which other end users (figure 3, reference 14) are subscribed in a presence database (figure 8, reference 42) (col. 14 lines 37-42); and

(b) a presence server (figure 8, reference 42) message generator for, if the communication module determines that presence registration processing is required, for receiving a copy of the SS7 message and for automatically generating a presence registration message including presence information usable by a presence server (figure 8, reference 42) for automatically indicating to the end users subscribed to the target end user a presence status for the target end user (figure 8, reference 48), wherein the presence server message generator is adapted to forward the presence registration message to the presence database (col. 14 line 37 to col. 15 line 7);

a communication medium for contacting the target end user and the fact that the target end user is currently available to receive text messaging protocol messages via the communications medium (col. 15 lines 2-7).

However, Sladek et al. does not disclose determining whether presence registration processing is required for the S S7 message. In an analogous art, Pirkola et al. disclose determining whether presence registration processing is required for the SS7 message (col. 13 lines 8-13).

Sladek et al. disclose a presence server database operatively associated with the presence server message generator (figure 9, col. 14 lines 37-42) and Pirkola et al. disclose updating the presence information in response to the presence-server-compatible message (as set forth in claims 30-32).

One skilled in the art would have recognized presence registration processing is required for the SS7 message to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at

the time of the invention, to use the presence registration processing is required for the SS7 message as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to constantly maintain updated status and location information in the subscriber's Home Function (col. 13 lines 2-5).

For claim 23, Sladek et al. disclose an advanced database communication module for encapsulating the presence registration message in an IP packet and transmitting the IP packet to a presence server over an IP network (col. 7 lines 11-12 and col. 16 lines 59-66).

For claim 29, Sladek et al. disclose automatic in-line messaging system, comprising:

(a) a communication module for receiving an SS7 message from an SS7 network (figure 9, col. 14 lines 37-42);

(b) a presence server message generator (figure 8, reference 42) for generating, based on the SS7 message, the presence information including a presence status for the target end user (figure 8, reference 48), wherein the presence server message generator is adapted to forward the presence-server-compatible message to the presence server database (col. 14 line 37 to col. 15 line 7);

Sladek et al. disclose a presence-server-compatible message (figure 8, reference 42). However, Sladek et al. do not disclose updating presence information regarding the target end user managed by a presence server. In an analogous art, Pirkola et al. disclose updating presence information regarding the target end user managed by a presence server (col. 2 lines 62-65).

One skilled in the art would have recognized updating presence information to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the updating presence information as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claim 33, Sladek et al. disclose wherein the presence server message generator is adapted to receive presence queries, forward the presence queries to a presence server database, and receive responses from the presence server database (figure 8, col. 14 lines 9-17).

For claims 42 and 46-47, Sladek et al. disclose automatic in-line messaging system, comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony related action performed by a target end user (figure 9, col. 14 lines 37-42);
- (b) in response to receiving the SS7 (SS7) message, formulating an internet protocol (IP) message for presence information regarding the target end user (figure 10, reference 82) managed by a presence server (figure 10, reference 76), the presence information including information usable by the presence server (figure 10, reference 76) for automatically indicating to end users (figure 10, reference 68) subscribed to the target end user (figure 10, reference 82) in a presence server database a presence status for the target end user (col. 16 line 49 to col. 17 line 11); and
- (c) transmitting the IP message to the presence server over an IP network (col. 7 lines 10-12).

However, Sladek et al. does not disclose updating presence information regarding the target end user managed by a presence server. In an analogous art, Pirkola et al. disclose updating presence information regarding the target end user managed by a presence server (col. 2 lines 62-65).

One skilled in the art would have recognized updating presence information to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the updating presence information as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claims 61-64, Sladek et al. disclose routing the SS7 message to its intended destination (figure 9, col. 14 lines 37-40 and col. 15 lines 4-7).

For claims 65 and 69, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

For claim 71, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

For claim 75, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

5. Claims 2-3, 27 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (US 6,718,178) in view of Pirkola et al. (US 6,611,516) further in view of Christie, IV (US 6,430,176).

For claims 2-3, 27 and 43-44, Sladek et al. in view of Pirkola et al. does not disclose a PSTN telephone to initiate a call from the target end user to the called party telephone number and the signaling system seven message is an IAM message. In an analogous art, Christie, IV discloses disclose a PSTN telephone to initiate a call from the target end user to the called party telephone number (col. 3 lines 22-24) and the signaling system seven message is an IAM message (col. 6 lines 12-16 as set forth in claims 2 and 43).

Christie, IV discloses the telephony-related action includes entering DTMF digits using a PSTN telephone handset after a call has been established, the DTMF digits forming a code for instructing an end office to formulate the SS7 message (col. 6 lines 4-7 as set forth in claims 3 and 44); wherein the SS7 message is an ISDN user part (ISUP) message (col. 6 lines 8-9 as set forth in claim 27).

One skilled in the art would have recognized a PSTN telephone to use the teachings of Christie, IV in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention, to use the PSTN telephone as taught by Christie, IV in Sladek et al.'s system with the motivation being to establish simultaneous voice and data (multimedia) communications between such telecommunications infrastructures (col. 1 lines 9-11).

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6. Claims 7-9, 24, 26, 34, 48-50, 66, 70, 72 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (US 6,718,178) in view of Pirkola et al. (US 6,611,516) further in view of Gudjonsson et al. (US 6,564,261).

For claims 7-9, 24, 26, 34, 48-50, 66, 70, 72 and 76, Sladek et al. in view of Pirkola et al. does not disclose a session initiation protocol (SIP) message. In an analogous art, Gudjonsson et al. disclose a session initiation protocol (SIP) message (col. 9 line 18 as set forth in claims 7, 24 and 48). Gudjonsson et al. disclose an instant messaging and presence protocol (BVIPP) message (col. 2 line 22 as set forth in claims 8, 26, 49, 66, 70, 72 and 76); and sending a second message to an accounting and billing system (col. 11 lines 10-15 as set forth in claims 9, 34 and 50).

One skilled in the art would have recognized a session initiation protocol (SIP) message to use the teachings of Gudjonsson et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the session initiation protocol (SIP) message as taught by Gudjonsson et al. in Sladek et al.'s system with the motivation being to establish a communication with another user (col. 9 lines 10-17).

Allowable Subject Matter

7. Claims 35-41 and 73-74 are allowed.

8. The following is an examiner's statement of reasons for allowance:

Regarding claims 35, the prior art fails to teach a combination of the steps of:

(b) a presence server message processor operably associated with the advanced database communications module for forwarding the

presence-server-compatible message to a presence server for determining the presence information, wherein the presence server stores the presence information for the first end user, and subscription information indicating a second end user subscribed to automatically receive presence information regarding the first end user and sends a response to the presence-server-compatible message to the second end user, thereby informing the second end user of the appropriate communications medium for contacting the first end user using text messaging protocol communications and whether the first end user is currently available to receive text messaging protocol message via the communication medium, in the specific combination as recited in the claim.

Response to Arguments

9. Applicant's arguments filed 11/19/04 have been fully considered but they are not persuasive.

The applicant argues with respect to claims 1, 5, 22, 29 and 42, that Sladek does not teach or suggest of generating presence status information based on a telephony-related action or of forwarding a presence registration message to a presence database. The examiner disagrees. Applicant's attention is directed to Sladek patent at col. 14 line 37 to col. 15 line 7 (in figure 9) where Sladek clearly teaches "At step 60, SMS logic 42 generates the specified text message. In doing so, SMS logic 42 retrieves the partially canned message from Mr. Smith's profile and notes that the message is supposed to include the name of the called party and data and time of the call. Given only the number of the called party, SMS logic 42 concludes that it must convert the dial

digits into the name of the called party. Thus, SMS logic 42 queries name/number database 50, to identify the subscriber name corresponding to the dialed subscriber number, and the database returns a string value, "Pete Harrison". In addition, SMS logic 42 identifies the current time as 14:34:03 and the current date as Jul. 29, 2004. SMS logic 42 then inserts these parameters into the partially defined message and establishes a complete informational text message, which reads, "George Smith called Pete Harrison at 14:34:03 on Jul. 29, 2004." And at col. 15 line 4 "Finally, at step 66, upon receipt of the SMDPP, MSC 26 then delivers the SMS message to MS 48, where the text message is displayed for viewing by Pete Harrison". The reference 42 should be in figure 8 instead of figure 9.

The applicant argues with respect to claims 2, 3, 27, 43 and 44, that Chritie does not teach or suggest using any ISUP message to trigger presence registration. The examiner disagrees. In claims 2, 3, 27, 43 and 44, there no "ISUP messages to trigger presence registration" recited limitations are claimed. Therefore, Christie does teach all recited limitation in the claims.

Furthermore, the applicant argues with respect to claims 7-9, 24, 26, 34, 48-50, 66, 70, 72, and 76, that Gudjonsson does nothing to connect these protocol as claimed in the claims of the present application. The examiner disagrees. Gudjonsson teaches at col. 8 line 66 to col. 9 line 7 "Referring to FIGS. 3-6, a function of the system/network is to provide the possibility for users 7 to establish arbitrary communication sessions with other users 7. Different types (e.g., voice or text) of communication may be established in different embodiments. The system/network handles the initial discovery

of the mutual communication channel using "invitations." "Invitations" may also be referred to as invitation messages or INVITE(s) herein, for the purposes of simplicity."

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

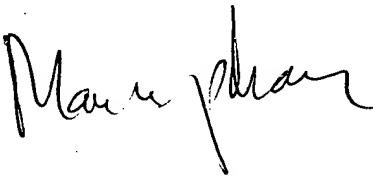
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D. Nguyen whose telephone number is 571-272-3153. The examiner can normally be reached on M-F (7:00AM-4:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 571-272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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MAN U. PHAN
PRIMARY EXAMINER